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10/804,744	03/19/2004	Amir Shahindoust	66329/00239	8274

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EXAMINER
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WILLIAMS, KIMBERLY A

ART UNIT	PAPER NUMBER
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2625

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/804,744

Applicant(s)

SHAHINDOUST, AMIR

Examiner

Kimberly A. Williams

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/19/04 and 8/27/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/394973. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of the present invention ('744) for printing documents from a portable data device corresponds to the system for generating an image from the mobile client device of claim 18 of the copending application ('973). The formatting means of '744 corresponds to the receiving and retrieving means of '973. The communicating means of '744 corresponds to the sending means of '973. These claims are obvious variations of one another. Claim 8 of the

present invention ('744) for printing documents from a portable data device corresponds to the method for generating an image from the mobile client device of claim 1 of the copending application ('973). The print request receiving step and document data receiving step of '744 corresponds to the converting step of '973. The communicating step of '744 corresponds to the sending step of '973. Claim 3 of '744 corresponds to claim 3 of '973. These claims are obvious variations of one another.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,4-9,11-23 and 25-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Bunn et al. (US 2003/0142345).

Regarding **claim 1**, Bunn teaches a system for printing documents from a portable device (102), comprising: print request receiver means (printer 106 via print by reference 128) adapted for receiving a print request from an associated portable data device, wherein the print request includes reference data (e.g., URL) representative of an electronic document stored in a location other than the portable data device (archive

file 132); document data receiver means (the proxy server 180 transmits the archive file to the printer 106); formatting means (remote print service 156 renders the content into printer-ready format); and communicating means (remote print service 156 transmits the rendered document to the printer; para. 21). **Claim 8** is the corresponding method of claim 1 and is rejected for the same reasons as above.

Regarding **claim 2**, Bunn teaches that the document data receiver means (the proxy server 180) includes a network (150), which may comprise the internet, WANs, LANs or other similar networks (para 13, last line; para. 23). **Claim 9** is the corresponding method of claim 2 and is rejected for the same reasons as above.

Regarding **claim 4**, Bunn teaches that the mobile device may transmit security information to gain access to a secure web page (para 23 last line). **Claim 11** is the corresponding method of claim 4 and is rejected for the same reasons as above.

Regarding **claims 5 and 12**, please note para. 12, lines 8-11.

Regarding **claim 6**, the print-by-reference (128) is an application. **Claim 13** is the corresponding method of claim 6 and is rejected for the same reasons as above.

Regarding claim 3, Bunn teaches spooling the page description language document to the printer (106; para. 15).

Regarding **claim 7**, the print-by-reference (128) application operates on the mobile device (102). **Claim 14** is the corresponding method of claim 7 and is rejected for the same reasons as above.

Regarding **claims 15-23 and 25-28**, the method of Bunn may be embodied in software or code (fig. 3, para 26).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 10 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bunn et al. in view of Nakagiri et al. (US 6924826).

Regarding **claims 3, 10 and 24**, Bunn fails to specifically disclose that the data is spooled prior to being formatted.

Nakagiri teaches document data that is generated from an application program wherein the data is spooled into an intermediate code before it is converted into a printer control command (fig. 3).

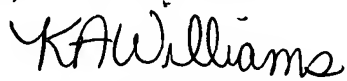
Bunn could be modified to spool the data before it is formatted for printing as taught by Nakagiri. This modification would have been obvious to one of ordinary skill in the art at the time of the invention for the purpose of being able to edit the spooled data before it is formatted for the printer.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly A. Williams whose telephone number is (571) 272-7471. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Kimberly A Williams  
Primary Examiner  
Art Unit 2625

KAW  
July 16, 2007